

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 16 and 20-26 will have been amended and are resubmitted for reconsideration by the Examiner. Claims 27-34 have been submitted for examination. Thus, claims 16-34 will remain pending in the present application.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acceptance of the drawings filed on May 9, 2005.

Turning to the merits of the action, the Examiner has rejected claim 23 because of informalities. By the present amendment, Applicant has amended claim 23 to eliminate the informalities. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 16, 18, 19, 22, 23, and 26 under 35 U.S.C § 102(e) as being anticipated by MISAWA et al. (U.S. Patent No. 6,771, 382). The Examiner has also rejected claim 17 under 35 U.S.C § 103(a) as being unpatentable over MISAWA et al. in view of TOYODA et al. (U.S. Patent No. 5,881,233). The Examiner has also rejected claims 20 and 24 under 35 U.S.C § 103(a) as being unpatentable over MISAWA et al. in view of SHOUJIMA (U.S. Patent No. 5,754,778). The Examiner has also rejected claims 21 and 25 under 35 U.S.C § 103(a) as being unpatentable over MISAWA et al. in view of TOYODA et al.

As noted above, Applicant has amended claims 16 and 20-26. Applicant respectfully traverses the above rejections based on pending claims 16-26 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

In particular, Applicant has deleted a recitation from each of the independent claims indicating that the scanner is distinct from the mail server. In this regard, this limitation in its various forms, was inserted into the independent claims based on a discussion with the Examiner in which the Examiner indicated that such a limitation would render the claims allowable. In view of the fact that the Examiner has now rejected the claims based on a new reference (MISAWA et al.), it is believed that the limitation now being deleted from the independent claims is not necessary for the patentability of the claims. In particular, it is quite clear based upon conventional usage within the technology area scanners are different than mail servers. Therefore, there is no need for this feature to be recited. Nevertheless, dependent claims have been submitted setting forth this feature to provide Applicant with the scope of coverage to which he is entitled.

Applicant's claims 16-22 generally relate to an electronic mail communication apparatus which transmits an e-mail to a destination via a mail server. The electronic mail communication apparatus comprises a scanner configured to scan image data and a memory configured to store a limit capacity of the mail server. The limit capacity indicates a maximum data amount that the mail server can store for one e-mail transmission. The electronic mail communication apparatus comprises a controller

which converts the image data into data for Internet transmission, attaches the converted data to the e-mail, and transmits, to the destination, the e-mail to which the converted data is attached, via the mail server. Further, the controller compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server, and notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server. Claims 23-26 recite a related method.

Regarding the rejection under 35 U.S.C. § 102(e) asserted by the Examiner, MISAWA et al. relates to a composite communication apparatus which, when a size of image data attached to an e-mail is larger than a predetermined reference value  $A_{ref}$ , transmits the image data by a facsimile transmission instead of an e-mail transmission. The predetermined reference value can be varied based upon an address area and a transmission time zone (col. 4, lines 59-67 and col. 5, lines 1-6) as shown in Fig. 7.

However, MISAWA et al. does not disclose at least a memory which stores a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission. Rather, MISAWA et al. discloses the storage unit 20 which stores predetermined reference values corresponding to address areas and transmission time zones (col. 4, lines 59-67 and col. 5, lines 1-6). The address areas and transmission time zones do not indicate a limit capacity of the mail server, since MISAWA et al. does not contain any disclosure regarding a mail server. The address areas and transmission time zones also do not

indicate a maximum data amount that the mail server can store for one e-mail transmission, for the same reason. Rather, Aref is based upon the possible slowing of communication speed when large data amounts are transmitted (col. 3, lines 62-67).

Moreover, while the Examiner asserts that the terminal unit (personal computer 60 of MISAWA et al.) is a mail server, there appears to be no basis for such characterization in the disclosure of MISAWA et al. In this regard, Applicant notes that claim 16 recites an electronic mail communication apparatus transmitting an e-mail to a destination via a mail server. Thus, according to the features of Applicant's claims, the mail server has to be intermediate or between the communication apparatus and the destination. Clearly, the terminal unit of MISAWA et al. is not intermediate a transmitting unit and a receiving unit or destination. Moreover, there is no discussion within MISAWA et al. regarding any storage capacity of the terminal unit 60.

Further, MISAWA et al. does not disclose at least a controller which compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server, since MISAWA et al. does not teach a memory which stores a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission. Rather, MISAWA et al. compares a size of compressed image data with the predetermined reference value corresponding to the address area and the transmission time zone (col. 5, lines 7-26).

In MISAWA et al., the reference value, which is used to determine when to switch between electronic mail transmission and facsimile transmission, is not related to a storage capacity of a mail server. Rather, it depends on the location of the addressee or the time zone. Thus, any comparison that takes place in MISAWA et al.

is only at best superficially related to the comparison performed by the controller. In this regard, the controller recited, for example in claim 16, compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server. This is clearly not taught, disclosed nor rendered obvious by MISAWA et al.

On the other hand, the present invention recites a memory which stores a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission. The present invention also recites a controller which compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server. Thus, pending claims are clearly distinguished over MISAWA et al.

Furthermore, regarding claim 19, MISAWA et al. does not teach that the maximum data amount comprises a smaller of a data amount that the transmitting mail server can store and a data amount that the receiving mail server can store, since MISAWA et al. does not contain any disclosure regarding the transmitting mail server and the receiving mail server, as recited in claim 19. Rather, MISAWA et al. merely teaches the predetermined reference value corresponding to the address area and the transmission time zone (col. 5, lines 7-27) and the predetermined reference value can be changed (col. 7, lines 5-31).

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16, 18, 19, 22, 23 and 26 are not disclosed in MISAWA et al. cited by the Examiner.

Regarding the rejection of claim 17 under 35 U.S.C. § 103(a) by the Examiner, the Examiner admits in the outstanding Official Action mailed on August 2, 2005 that

MISAWA et al does not disclose a speaker which notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server, via a sound.

TOYODA et al. relates to a facsimile mail apparatus. The sixth embodiment of TOYODA et al. discloses a facsimile mail apparatus that converts image data as well as audio data into one e-mail format and transmits the image/audio data of the e-mail format to a destination via a network (Fig. 11, Fig. 12, col. 11, lines 22-67 and col. 12, lines 1-65).

However, TOYODA et al. do not disclose a speaker which notifies a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server, since TOYODA et al. does not compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server. Rather, TOYODA et al. discloses the audio input/output device 14 utilized for inputting the transmitted audio data into the facsimile mail apparatus (Fig.12 S52, col. 11, lines 63-37 and col. 12, lines 1-12). Thus, the audio input/output device 14 is not utilized for notifying a user of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server.

Thus, the pending claims are clearly distinguished over TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claim 17 are not disclosed in TOYODA et al. cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since MISAWA et al. and TOYODA et al. (in any proper combination) do not disclose

the combination of features recited in Applicant's claim 17. Neither of these references disclose, *inter alia*, a memory that stores a limit capacity of a server.

Nor would there be any reason for modifying the disclosure of MISAWA et al. to utilize the speaker in the manner recited in Applicant's claim 17. In MISAWA et al., regardless of the amount of data being transmitted, the data is transmitted either via facsimile or via e-mail. Thus, there is no reason to provide an indication to the user that a capacity has been exceeded. Moreover, the Examiner has not set forth a proper motivation for combining the features of TOYODA et al. and MISAWA et al. There is nothing in the prior art that provides a motivation for modifying MISAWA et al. with the speaker of TOYODA et al.

Regarding the rejection of claims 20 and 24 under 35 U.S.C. § 103(a), the Examiner admits in the outstanding Official Action mailed on August 2, 2005 that MISAWA et al does not disclose a controller which divides the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converts the divided image data into data for the Internet transmission, attaches each of the divided and converted data to an e-mail, and transmits, to the destination, each e-mail to which the divided and converted data is attached, via the mail server.

SHOUJIMA relates to an e-mail system including the mail server 10 and the receiving terminal 20. The e-mail server 10 stores an e-mail directed to the receiving terminal 20. The receiving terminal 20 requests the e-mail from the mail server 10. The mail server divides an e-mail into a plurality of portions, based on the available

capacity of the receiving terminal 20. The mail server 10 transmits each portion of the divided e-mail to the receiving terminal 20 (col. 3, lines 14-30).

However, SHOUJIMA does not disclose at least a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission. Rather, SHOUJIMA discloses the mail server 10 which includes the divided mail memory section 14 that stores the divided e-mail (col. 4, lines 15-35). The divided e-mail does not indicate a limit capacity of the mail server 10.

SHOUJIMA also does not disclose at least the controller which compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server. Rather, SHOUJIMA discloses the mail server 10 which determines a limit memory size of the portion, based on the size of the common header section and on the available capacity of the memory section 24 of the receiving terminal 20 (col. 4, lines 36-40).

Further, SHOUJIMA does not disclose at least a sending terminal which divides the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converts the divided image data into data for the Internet transmission, attaches each of the divided and converted data to an e-mail, and transmits, to the destination, each e-mail to which the divided and converted data is attached, via the mail server. It is noted that SHOUJIMA contains a description of the mail server 10, but does not contain a disclosure of the sender as set forth in the claims defining. In SHOUJIMA, while the mail server 10 divides an e-mail into a plurality of portions, based on the available

capacity of the receiving terminal 20 (col. 3, lines 14-18), a sending terminal as recited with respect to the present invention does not divide an e-mail into a plurality of portions before transmitting the e-mail to the mail server 10.

On the other hand, the present invention relates to an electronic mail communication apparatus which transmits an e-mail to a destination via a mail server, but not to the mail server itself. The electronic mail communication apparatus recites a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission. The electronic mail communication apparatus also recites a controller which compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server. Further, the electronic mail communication apparatus recites divides the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converts the divided image data into data for the Internet transmission, attaches each of the divided and converted data to an e-mail, and transmits, to the destination, each e-mail to which the divided and converted data is attached, via the mail server.

Thus, the pending claims are clearly distinguished over SHOUJIMA.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 20 and 24 are not disclosed in SHOUJIMA cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since MISAWA et al. and SHOUJIMA do not disclose the combination of features recited in Applicant's claims 20 and 24.

Nor is there any proper motivation set forth in the Official Action for modifying the teachings of MISAWA et al. to include the features of SHOUJIMA. The mere assertion that a system would become more efficient is not adequate to evidence proper motivation. This is merely a speculation on the part of the Examiner and does not appear to be supported by the prior art of record.

Regarding the rejection of claims 21 and 25 under 35 U.S.C. § 103(a) by the Examiner, the Examiner admits in the outstanding Official Action mailed on August 2, 2005 that MISAWA et al does not disclose a controller which reduces the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, converts the reduced image data into data for the Internet transmission, attaches the converted data to the e-mail, and transmits, to the destination, the e-mail to which the converted data is attached, via the mail server.

TOYODA et al. does not disclose at least a memory stores a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission. The recitation portion recited by the Examiner (col. 12, lines 25-33) does not contain disclosure regarding any type of memory.

TOYODA et al. also do not disclose at least a controller which compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server, since TOYODA et al. does not disclose a memory which stores a limit capacity of the mail server. The recitation portion recited by the Examiner (col. 12, lines 19-33) does not contain disclosure regarding any type of comparison.

Further, TOYODA et al. does not disclose at least a controller which reduces the data amount of the image data by changing a resolution of the image data "when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server". Rather, TOYODA et al. merely discloses the data compressor/expander 8A which compresses the binary image data into compression-resultant image data of a given facsimile format (col. 12, lines 28-33).

Thus, the pending claims are clearly distinguished over TOYODA et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 21 and 25 are not disclosed in TOYODA et al. cited by the Examiner. The pending claims are submitted to also be patentable over the Examiner's proposed combination, since MISAWA et al. and TOYODA et al. do not disclose the combination of features recited in Applicant's claims 21 and 25.

Nor is there any proper motivation for the proposed combination. As noted above, the Examiner's general assertion that the modification would result in increased efficiency is merely speculation on the part of the Examiner.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and an indication of the allowability of all the claims pending in the present application in due course.

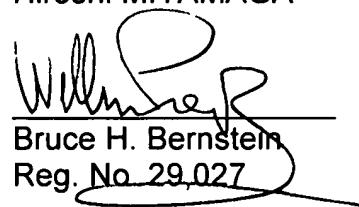
**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the new claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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